

REMARKS – General

1. Re Examiner's response [1], the Applicant duly notes response.
2. Re Examiner's response [2], the Applicant duly notes response.
3. Re Examiner's response [3] and [4], Claims **14-20**, and **34-44** were rejected under 35 U.S.C. 112, second paragraph. Applicant respectfully requests that the claims of record be amended under Rule 116, i.e. 37 CFR 1.116 as submitted in this response to overcome this rejection.
4. Re Examiner's response [4], "**Applicant claims a method in the preamble of claim 1**" had been previously replaced with Claim 14.
5. Re Examiner's response [5], the use of the trademark BLUETOOTH is commonly used in issued US PTO patents. Usage is not only in the Claims, but in the Specification and the Abstract of the issued patents, without reference to any trademarks and as an accepted term for a technology standard.

A search by the Applicant using the term BLUETOOTH was done against the US PTO's "Issued Patents" database ("ACLM/bluetooth"), which returned 924 patents that currently use the term BLUETOOTH in each listed patents' Claims section. Enclosed please find a copy of a section of the "Issued Patents" search results.

Applicant respectfully submits that the technology term BLUETOOTH is similarly accepted and used today by industry, etc. as the term "Ethernet" is used and accepted. Ethernet is a trademark of the Xerox Corp. and is currently used in 2,434 US PTO patents' Claims sections.

Based on these precedents, Applicant respectfully requests that the Examiner reconsiders the rejection of Claims 16 and 38 as “**rendered indefinite by the use of the trademark term BLUETOOTH**”.

The Claims All Distinguish Over The Reference Cited Under Sec. 102

6. The Applicant’s independent claims, and hence all dependent claims, distinguish over the reference under Sec. 102, because they cite a method to provide for creating a consumer’s shopping list[s] prior to entering, i.e. without having necessarily to enter physically a store by scanning or manually entering the UPC barcode of a needed item; providing a means to automatically add a regularly purchased item to the shopping list without further user assistance once a buying pattern has been established and electronically transmitting the shopping list to an online store for pickup or shipping. The Applicant has requested that the claims of record be modified under 37 CFR 1.116 to further clarify Applicant’s invention over the Examiner’s relied upon reference Ruppert et al.

7. The cited and relied upon Ruppert et al. discloses a system whereby a shopper uses a previously created “*universal*” (col. 5 lines 6-20) shopping list in the PERSONAL SCANNER™ (see abstract: “*The user selects a shopping list from a collection... or by spelling out the items to purchase on a keyboard.*”; (see col. 4, lines 28-47; col. 4, lines 63-66; col. 5 lines 5-20; col. 5 lines 29-40; col. 6 lines 58-66).

The PERSONAL SCANNER™ is then taken to a store and it is used to check off products picked off the shelves against the selected shopping list, by scanning in their barcodes (see col. 5, lines 34-40).

Ruppert et al. also teaches a method whereby the shopper can add scanned items that were not previously stored in the PERSONAL SCANNER™ shopping list, but this is done only when the shopper is physically in the store (see col. 6, lines 49-55).

The Applicant’s invention teaches the primary use of scanned product barcodes, without entering a store, to create shopping lists. This method eliminates the need to use complex logic (e.g. using “*fuzzy logic*” as described in Ruppert et. al.) to match a user’s

selections with those of the store's definitions (see col. 15, lines 24-65). Furthermore, Ruppert et al. do not teach the capture and use of the date and time on which an item was added to a shopping list. Applicant's invention teaches the use of this timestamp data to predict when a regularly needed consumer's item should be acquired. Ruppert et al. do not teach this method.

7 (a) Re the Examiner's Final Response:

(i) Page (3), reference "**Ruppert a method for creating a consumer's shopping list prior to entering a store**", Applicant respectfully submits that Ruppert does not teach the creation of a shopping list prior to entering a store by the consumer scanning needed products' UPC barcodes, as does the Applicant's invention. Ruppert et al. teach modifying pre-stored shopping lists (col. 4 lines 64-68; col. 5 lines 1-33; col. 6 lines 60-66), as well as modifying the pre-stored shopping list whilst in-store (col. 6 lines 49-55). To emphasize the use of pre-existing lists, Ruppert et al. teach an embodiment, i.e. a "*model*" (col. 5 line 32) as described by Ruppert et al. which incorporates only a single, pre-stored shopping list for the consumer (col. 5 lines 26-33).

Furthermore, Ruppert et al. teach an apparatus to be used in-store [Abstract, lines 58-102; Fig. 5; Fig. 7; Fig. 11; col. 2 lines 10-25; col. 2 lines 35-38; col. 2 lines 47-50; col. 3 lines 2-4; col. 3 lines 26-30; col. 4 lines 33-35; col. 5 lines 34-40; col. 5 lines 62-68; col. 6 lines 1-18; col. 6 lines 27-38; col. 6 lines 49-55; col. 8 lines 1-5; col. 8 lines 63-66; col. 9 lines 1-68; col. 10 lines 25-30; col. 10 lines 43-68; col. 11 lines 11-26; col. 12 lines 20-68; col. 13 lines 19-25; col. 15 lines 14-16]. Ruppert et al. do not teach the use of incorporating a UPC barcode scanner to shop with online, as does the Applicant's invention, with shopping list items either shipped by the online store, or packed for later pickup by the consumer at the store.

(ii) Page (3), Examiner's reference "**(fig. 5 block 56)**", Fig. 5 does not have a "**block 56**", but does have numbered blocks between 84 and 108.

(iii) Page (4), Examiner's reference "**(see col. 8 lines 50-53)**" teaches downloading "*the store's current price list by dialing the store computer*" to the scanner. This cited reference does not teach the Applicant's method of using a scanner with "logic that indicates that said product barcode or said product coupon barcode has been transmitted to one or more first computers over said first network infrastructure". In the Examiner's reference, Ruppert does not teach that data has been successfully downloaded to the scanner. Furthermore, in this cited reference, Ruppert et al. do not teach downloading data from the scanner to a computer. This cited reference teaches downloading data in the opposite direction as claimed by the Applicant and would not achieve what the Applicant claims.

(iv) Page (4), Examiner's references "**(fig. 1 block 24)**" and "**see at least fig. 1 block 24, abstract, coupons are matched and discounted**" do not teach the storing of the date and time of the scanned item's event as the Applicant teaches. This is important because without this information the predictive means that the Applicant's invention teaches would not be possible, i.e. the frequency with which products are repeatedly purchased [Applicant's Claim 14 (b)(vi), Claim 14 (b)(ix), Claim 36 (b)(vi) and Claim 36 (b)(ix)].

(v) Page (4), Examiner's reference "**(fig. 5 block 192)**", Applicant found no such reference in Ruppert's Fig. 5. Fig. 5 has labels numbered between 84 and 108.

(vi) Page (5), Examiner's reference "**(see col. 8 lines 50-53)**", Ruppert teaches the downloading of the "*store's current price list*" to the scanner from the store computer, whilst the Applicant's claim refers to a scanner using "logic that indicates that said product barcode or said product coupon barcode has been transmitted to one or more first computers over said first network infrastructure", i.e. providing user feedback that data has been electronically transmitted from the scanner to another computer device and not to the scanner from a store computer as taught in the Examiner's reference "**(see col. 8**

lines 50-53)". Furthermore, the Examiner's cited reference does not teach any indication that data has been successfully transferred.

(vii) Page (5), Examiner's reference "**(see col. 2 lines 43-53)**", Ruppert teaches the downloading of product coupons associated with a store's price list. This reference does not teach a "consumer's first computer" using "logic that provides notification of repetitively scanned said product barcodes or said product coupon barcodes", as does the Applicant's invention. As mentioned previously this is important, because without this logic the predictive means that the Applicant's invention teaches would not be possible, i.e. the frequency with which products are repeatedly purchased [Applicant's Claim 14 (b)(vi), Claim 14 (b)(ix), Claim 36 (b)(vi) and Claim 36 (b)(ix)].

(viii) Page (5), Examiner's reference "**(see col. 6 lines 1-18)**", Ruppert teaches the downloading of the physically entered store's current price list to the scanner from the store computer. This reference does not teach a scanner "transferring said scanned product barcode or said product coupon barcode to said first computer, over said first network infrastructure", i.e. in the Examiner's reference Ruppert et al. do not teach the transferring of data from the scanner to another computer as claimed by the Applicant. Examiner's reference teaches the downloading of data from the physically entered store computer to the scanner, i.e. in the opposite direction as claimed by the Applicant and would not achieve what the Applicant claims.

(ix) Page (5), Examiner's references "**(col. 7 lines 13-20, fig. 6 111)**", in the first Examiner's reference, i.e. "**(col. 7 lines 13-20)**" Ruppert et al. teach making changes to a shopping list, which are then "*spelled out by the user by selection of letters and/or numbers*" (col. 7 lines 14-15). Examiner's second reference, i.e. "**fig. 6 111**" is a flowchart question-block titled "*STORE IN DATABASE*". This block 111 is part of a flowchart in Ruppert et al. Fig. 6 that deals with the process to "*RETRIEVE STORE PRICE LIST AND SET BUDGET*" in the Ruppert scanner device and not on a "first

computer” as claimed by the Applicant, or as currently requested under 37 CFR 1.116 for claim modification, on a “consumer’s first computer”. Furthermore neither of the Examiner’s references mentions the capture of the “date and time on which said product barcode was scanned” as claimed by the Applicant. As mentioned previously this is important, because without this information the predictive means that the Applicant’s invention teaches would not be possible, i.e. the frequency with which products are repeatedly purchased [Applicant’s Claim 14 (b)(vi), Claim 14 (b)(ix), Claim 36 (b)(vi) and Claim 36 (b)(ix)].

(ix) Page (6), Examiner’s reference “(see col. 12 lines 23-26,)” teaches the use of a magnetic strip to prevent “*shoppers from putting things in their carts which have not been scanned*” (col. 12 lines 20-21). Although not clearly stated in Ruppert, it can be assumed that the security magnetic strip is placed on each purchasable item in the store. Ruppert et al. do mention that “*other information such as unit price, etc. may be printed*” (col. 12 lines 25-26), but this form of “printing” is not what the Applicant claims. The Applicant is simply claiming the printing out of the shopping list on a standard PC printer, e.g. an HP LaserJet, etc. Applicant respectfully claims that a magnetic strip on an individual product in no way compares with printing out a shopping list containing multiple products on a standard PC printer. Reading a list on a magnetic strip is limited not only physically (i.e. to storing only the specific product’s data and not a complete multi-product shopping list), but needs special equipment as well, whereas a printed-paper list requires only human sight.

(x) Page (6), Examiner’s reference “(g)....(col. 6 lines 1-19,)” teaches the downloading of a store’s “*price list*” (col. 6, lines 1-3; col. 6, lines 5-7; col. 6, line 12-23; col. 12, lines 15-16) to Ruppert’s scanner from the store’s computer upon physical entry to the store. Applicant is claiming sending, i.e. electronically transmitting the shopping list from a “first computer” and not from the scanner to an online store via a network; the store’s staff then gathers the products on the electronically sent shopping list and then ships (e.g. via FedEx or UPS) the products to the consumer thereby fulfilling the placed order. Applicant respectfully claims that the Examiner’s reference does not teach

what the Applicant has claimed.

(xi) Page (6), Examiner's reference "(h)...(**col. 6 lines 1-19**)" teaches the downloading of a store's price list (col. 6, lines 1-3; col. 6, lines 5-7; col. 6, line 12-23; col. 6, lines 15-16) to Ruppert's scanner from the store's computer upon physically entering to the store. Applicant is claiming sending, i.e. electronically transmitting the shopping list from a "first computer" and not from the scanner to an online store via a network; the store's staff then gathers of the products on the sent shopping list and holds the products for the consumer to pick up later. Applicant respectfully claims that the Examiner's reference does not teach what the Applicant has claimed.

(xii) Page (7), Examiner's response "**for receiving product identification data from a UPC**", Applicant respectfully could find no reference to "UPC" in Ruppert et al. It is commonly known in the art that not all barcodes are UPCs. UPC is one of many symbologies used by barcode scanners.

(xiii) Page (7), Examiner's reference "(see **col. 6, lines 49-55**)" teaches generating a list and not "**selected by a consumer for inquiry (see col. 6, lines 49-55)**".

8. Since the Applicant's independent claims recite features that are not present in any reference, Applicant submits that the claims, and hence all dependent claims clearly recite a novel method over the cited reference under Sec. 102.

The Novel Features Of The Claims Provide New and Unexpected Results And Hence Should Be Considered Unobvious, Making The Claims Patentable Under Sec. 103

9. Applicant submits that the above recited novel features in the Applicant's independent claims, and hence in all claims, provides new and unexpected results and hence should be considered unobvious, making the claims patentable under Sec. 103.

10. Specifically, by providing the consumer with a method to create a shopping list, without having necessarily to enter a store physically or modifying pre-stored lists in a scanner, by scanning a product UPC barcode into a system that yields a usable in-hand shopping list (i.e. in electronic or print format). The consumer only needs to know how to scan in, or manually enter a product's UPC barcode. The collected barcodes, i.e. needed products are then downloaded to a consumer's PC (i.e. not a store computer), which then gathers all other related information about the barcoded products via the internet. The consumer can either print out or download to a portable electronic device such as a PDA the shopping list stored on the consumer's PC and physically go to a store to shop for the items. Optionally, a method is taught that enables the consumer to transmit electronically his shopping list to an online store, which either ships the products on the consumer's shipping list to him, or packs all of the products for later pick up by the consumer, i.e. in both of these methods without the consumer having to shop physically in-store for the products on his shopping list. An important method of the Applicant's patent is the systematic learning of the consumption habits of the consumer. Noting the date and time on which product barcodes are entered by the consumer and then tracking the frequency (i.e. consumption pattern) of the entered barcodes achieves this. In other words, the Applicant's invention includes providing a predictive database of user scanned/entered products that the consumer regularly uses, and automatically adds these to the shopping list.

Request For Constructive Assistance

The undersigned has made a diligent effort to amend the claims of this application so that they define a novel method, which is also submitted to render the claimed method unobvious because it produces new and unexpected results. If, for any reason the claims of this application are not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more claims pursuant to **MPEP 707.07(j)**, or in making constructive suggestions pursuant to **MPEP 706.03(d)** in order that this application can be placed in allowance as soon as possible and without the need for further proceedings.

Very Respectfully,

Lester Sussman

Applicant Pro Se

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I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Box AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 21313-1450" on the date below.

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Lester Sussman, Applicant